

REMARKS

In response to the Office Action dated January 6, 2006, Applicants submit the following remarks.

In the Office Action, the Examiner issued a requirement that Applicants make an election between the Group I claims (Claims 1-5 and 18), the Group II claims (Claim 6-13 and 17) and the Group III claims (Claims 14-16). Applicants hereby provisionally elect Group I, but this election is made with traverse and is solely for the purpose of advancing prosecution of the case.

The Examiner also issued an election of species requirement as between the various forms of pleuromutilins recited in the claims. Applicants hereby provisionally elect species 1-Tiamulin, but this election is also made with traverse and is solely for the purpose of advancing prosecution of this case.

It is believed that the requirement to restrict the invention is improper. The Examiner asserts that there is a lack of unity under PCT Rule 13 in that the common technical feature of all the claims is not a contribution over the prior art. The Examiner contends that this common technical feature is simply pleuromutilin, but has not demonstrated why this fact alone justifies imposition of a restriction requirement given the way the claims are worded. In fact, Applicants submit that the Examiner has characterized the common technical feature too broadly compared to the claims proposed by Applicants in this case.

The common technical feature is not merely pleuromutilins, but instead is pleuromutilins effective in the treatment of *Mycobacterium* infections, such as tuberculosis. The Group I claims specifically call for treatment of *Mycobacterium* disease using a pleuromutilin. The Group II claims recite specific pleuromutilin compounds which have been found to be effective for this purpose. Finally, the Group III claims recite pharmaceutical compositions using the compounds of Group II which are effective in treating *Mycobacterium* infections. Thus, in each group, the common technical feature is a pleuromutilin which is effective in treating *Mycobacterium* infections.

As a practical matter, examination of any one of the three claim groups will require a search of substantially the same prior art as an examination either of the other two groups. Each would require searching all of the art relating pleuromutilins which are effective in treating *Mycobacterium* infections. Furthermore, separate examination of the three claim groups may lead to inconsistent examinations and likely will result in duplication of effort. It is a more efficient use of Patent Office manpower and resources to examine all claims which are closely related at one time, rather than conducting separate examinations.

The mere fact that one set of claims is directed to a method and another set is directed to a compound or composition which may be used in the claimed method does not mean a patent cannot properly be issued containing both sets of claims. Patents are routinely validly issued containing both method and compound/composition claims.

Moreover, restriction is not "required" by 35 U.S.C. §121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to impose restriction when appropriate. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted...." (emphasis added). Likewise, the MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

Because the Examiner has not shown any serious burden if examination of all the claims is conducted in one proceeding and the claims cover closely related subject matter, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement and examine Claims 1 - 18.

Application No. 10/509,502
February 6, 2006

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355**.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

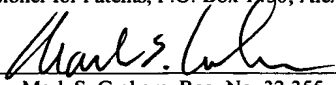
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on February 6, 2006
Date


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